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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.	:	09/739,023			
Applicant	:	Andrea Michalik			
Filed	:	December 8, 2000			
Title	:	**VARIETY OF GERANIUM PLANT NAMED 'PENLAVA'**			
Group Art Unit	:	1661	Confirmation No.	:	4154
Examiner	:	Wendy C. Haas	Customer No.	:	28289

APPEAL BRIEF

MAIL STOP APPEAL BRIEF – PATENTS
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed on July 5, 2005 appealing the final rejection of claim 1. As September 5, 2005 fell on a Federal Holiday, this Appeal Brief has been timely filed on September 6, 2005.

The headings used hereinafter and the subject matter set forth under each heading are in accordance with 37 C.F.R. §41.37.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to MAIL STOP APPEAL BRIEF – PATENTS, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on September 6, 2005.

Florence P. Trevethan
(Name of Person Mailing Paper)

Florence P. Trevethan 09/06/2005
Signature Date

I

REAL PARTY IN INTEREST

Elsner pac Jungpflanzen is the Assignee of the entire right, title, and interest to the above-identified application and, as such, is the real party in interest in this Appeal.

II

RELATED APPEALS AND INTERFERENCES

Other Appeals known to the Appellant, the Appellant's legal representative, or the Assignee of the present application which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal include Appeals filed in the following applications assigned to the Assignee of the present application: 09/664,247; 09/733,016; 09/733,020; 09/733,648; 09/753,976; 09/754,755 and 10/023,357. Application Number 09/664,247 was also the subject of an appeal to The Court of Appeals for the Federal Circuit (CAFC). A copy of decisions rendered by the Board and the CAFC is contained in the (Appendix B) Related Proceedings Appendix.

There are no interferences known to the Appellant, the Appellant's legal representative, or the Assignee of the above-identified application which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

III

STATUS OF CLAIMS

Claim 1 stands finally rejected under 35 U.S.C. §102(b) for anticipation by European Community Plant Breeders' Rights Application No. 19981665, published at least as early as August 16, 1999, that matured into CPVO Grant No. 7048, published on June 15, 2001, in view of a sale of a plant named 'Penlava' in Germany on March 1, 1999;

Claim 1 is reproduced in Appendix A which is attached hereto.

IV

STATUS OF AMENDMENTS

No response after the final Office Action dated April 5, 2005 has been submitted in this case. There was no claim change made after the final Office Action. The claim on appeal is the claim as filed with the application on December 8, 2000 which refers to the specification and drawing, the specification having been amended and a new drawing added by the Amendment of January 2, 2004.

V

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 on appeal in the present application is directed to a variety of geranium named 'Penlava' which is described in detail on four pages of the specification and illustrated in two photographic drawings. The claimed variety resulted from the crossing of dark leafed geranium breeding varieties and possesses all of the botanical characteristics fully described and shown in the present application.

VI

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following ground of rejection is addressed in this Appeal:

Is claim 1 anticipated by European Breeders' Rights Application No. 19981665, published at least as early as August 16, 1999, that matured into CPVO Grant No. 7048, published on June 15, 2001 (hereinafter collectively "PBR documents") in view of a sale of a variety of geranium named 'Penlava' outside of the United States on March 1, 1999?

VII

ARGUMENTS

I. An anticipation rejection cannot be built from multiple references.

The sale of a variety of geranium named 'Penlava' outside the United States only indicates that a geranium plant was in the possession of the public one year prior to the patent application filing date. To the extent that the sold variety was the same as the claimed variety, such a sale outside the United States is not a statutory bar under 35 U.S.C. §102(b) which prohibits patenting of an invention which "was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country".

Combining the sale of a claimed variety outside the United States with the scant disclosure in a PBR application constitutes improper use of prior art under 35 U.S.C. §102(b) to build an "anticipation" rejection. It is well-settled that teachings of multiple references may not be combined to build an anticipation rejection. Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc., 726 F.2d 724, 727, 220 USPQ 841, 842 (Fed. Cir. 1984).

The anticipation rejection in the present application has been characterized as based on the cited PBR documents. According to the Examiner, the cited PBR documents teach every material element of the claim, despite their severe lack (or absence) of botanical information. The sale of a plant named 'Penlava' outside the United States supposedly is used to show that the plant disclosed in the PBR documents was in the public domain more than one year prior to the application filing date.

The rejection is flawed in its reliance on publications which do not disclose every material element of the claim and its attempt to circumvent 35 U.S.C. §102(b) to reject a claim on an invention that may have been sold outside the United States.

The Office Action of October 2, 2003 recognizes that a publication which is relied upon as prior art under 35 U.S.C. §102(b) must be enabling. Moreover, it is admitted at page 2 of that Office Action that a PBR application" by itself would not be an enabled publication, were the plant not in the public domain". To account for the deficient teachings

of a PBR application, namely, the inability of a PBR application to enable the claimed plant, the rejection is supplemented by possible prior public availability of the claimed plant.

The following comments set forth the proper standards for using multiple references in a §102(b) rejection, namely, how an additional printed publication (a true §102(b) reference) may be used to show that anticipatory prior art is in the public domain.

II. Use of multiple references to make a rejection under 35 U.S.C. §102(b)

It is well-established that a printed publication which discloses "every material element of the claimed subject matter" constitutes a bar under 35 U.S.C. §102(b) if more than one year prior to an application's filing date, it placed the claimed subject matter "in possession of the public'. In re Samour, 571 F.2d at 562, 197 USPQ at 3. See also, In re Donohue, 766 F.2d at 533, 226 USPQ at 621 ("It is well settled that prior art under 35 U.S.C. 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it").

A. Anticipation rejections based on multiple references require a primary enabling disclosure and a second written reference.

There is some flexibility in the rule that only one reference may be used in an anticipation rejection. An additional reference may be used to prove that the primary reference discloses subject matter which is in the public's possession. MPEP §2131.01. Pursuant to this exception, a secondary reference may be included in an anticipation rejection only when the primary reference in and of itself is an enabling disclosure. An additional reference may be used to show what the primary reference contains -- and not to supplement what the primary reference lacks. In both of In re Samour and In re Donohue (each relating to patent applications on chemical inventions), an additional written reference was relied upon to show that the subject matter of a primary reference was available to the public. Neither case stands for the proposition that an additional reference may be used to supplement a non-enabling disclosure of a primary reference.

The claim at issue in In re Samour was directed to a specific chemical compound with the structure appearing in the claim. A first prior art reference disclosed the

structural formula set forth in the claim, but the reference did not disclose a method for its preparation. Hence, the applicant argued that the first reference was non-enabling. In response, the Examiner cited an additional reference which disclosed a method for preparing similar types of compounds. On appeal from a final rejection, the Patent and Trademark Office Board of Appeals agreed that the additional reference provided a legally sufficient teaching of how to make the compound disclosed in the first reference. The court agreed that the mere recitation of the chemical formula of the claimed composition in a prior art reference would not have been sufficient to place the compound in the public's possession. Yet, the court was willing to consider relying on additional references:

> ... [s]olely as evidence that, more than one year prior to appellant's filing date, a method of preparing the claimed subject matter (DMMP) would have been known by, or would have been obvious to, one of ordinary skill in the art. Therefore, the key issue before us is whether the PTO, in making a rejection under 35 USC §102(b) on a single prior art reference that discloses every material element of the claimed subject matter, can properly rely on additional references for such purpose.

Id. at 562, 197 USPQ at 4 (emphasis added).

The court maintained the rejection of the claim for the chemical compound based on the combined teachings of the printed publication disclosing the compound and a reference which disclosed a method for making similar compounds explaining that the additional reference cited in the §102(b) rejection was "not relied on for a suggestion or incentive to combine teachings to meet the claimed limitations" (as in a rejection under 35 U.S.C. §103), but, rather, to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in the possession of the public. Id. at 563, 197 USPQ at 4.

The Samour court did not import any disclosure from the secondary reference into the disclosure of the primary reference which taught every material element of the claimed compound. Every material element of the claim was the structural formula of the claimed compound. The primary reference disclosed that same structural formula. The secondary reference was only used to demonstrate that the claimed subject matter, which was fully disclosed in a printed publication, was available to the public.

A similar reasoning and result was found in In re Donohue where a claim also directed to a set of chemical compounds was rejected for anticipation by a primary reference that did not disclose methods of preparing the claimed compounds. Additional references relied upon by the United States Patent and Trademark Office taught how such compounds could be produced. The legal basis for upholding the rejection was outlined as follows:

> It is well settled that prior art under 35 U.S.C. §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. *In re Sasse*, 629 F.2d 675, 681, 207 USPQ 107, 111 (CCPA 1980); *In re Samour*, 571 F.2d at 562, 197 USPQ at 4; *see also Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 64, 651-52, 223 USPQ 1168, 1173 (Fed. Cir. 1984). Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. *See In re LeGrice*, 301 F.2d at 939, 133 USPQ at 373-74. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. *In re Borst*, 345 F.2d 851, 855, 45 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973, 148 USPQ 771 (1966).

Id. at 533, 226 USPQ at 621 (footnote deleted).

The court specifically followed the rule of Samour to determine that the claimed subject matter was in the public's possession by looking to additional references.

> The additional references utilized in this case (viz., Lincoln and Wagner) are not relief [sic] upon for suggestion or motivation to combine teachings to meet the claim limitations, as in rejections under 35 U.S.C. § 103. *In re Samour*, 571 F.2d at 563, 197 USPQ at 4-5. Such reliance would be pointless because Nomura [the primary reference] discloses every element claimed. The purpose of citing Lincoln and Wagner is, instead, to show that the claimed subject matter, as disclose [sic] in Nomura, was in the public's possession.

Id.

Both In re Samour and In re Donohue involved claims to a class of chemical compounds that was fully disclosed in a prior art reference. The secondary references (printed publications) in both cases were not employed to supplement any need for additional disclosure not present in the primary reference so that one skilled in the art could comprehend the scope of that referenced disclosure but only to show that the claimed chemical compounds were within the public domain. In other words, on their faces, the primary references were "enabling" because they taught every material element of the claimed subject matter. The only reliance on a secondary reference was to show that the claimed subject matter was in the public's possession one year prior to the filing date of the patent applications for the chemical compounds.

This line of case law was recently followed in Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc. et al., 246 F.3d 1368, 58 USPQ2d 1508 (Fed. Cir. 2001). Ben Venue and its codefendants alleged invalidity of a patent obtained by Bristol-Myers for a method of treating a cancer patient having steps of (i) premedicating the patient with a first drug and (ii) administering a second drug. The defendants argued that Bristol's claim was anticipated by a prior art reference which not only described treating patients with the second drug (i.e., the second step) but also suggested that "[f]urther studies are needed to see if *pretreatment regimens* [i.e., the first step], ... will permit the safe administration of this compound". Id. at 1372, 58 USPQ2d at 1515-1516. At issue was whether the prior art reference which mentioned a pretreatment regimen was "enabling to one of skill in the art" one year before the filing date of Bristol's patent application based on additional references and teachings to pretreat cancer patients. Following both Samour and Donohue, the court noted that enablement of an anticipatory reference may be demonstrated by another reference (as in Samour and Donohue, a printed publication) and restated the requirement of "a showing of each limitation of a claim in a single reference" for anticipation. Id. The court concluded that it was proper to look at other references to establish that the pretreatment regimen mentioned in the primary reference was in the public domain one year prior to Bristol's filing date. As was true for the claims at issue in Donohue and Samour, every material element of the claim in Bristol-Myers was present in the primary reference, namely, (i) premedicating a patient with a first drug and (ii) administering to the patient a second

drug. The primary reference contained both of those limitations and additional printed publications were only relied upon to show that premedicating a patient was within the public domain one year prior to the filing date of the patent application. No subject matter from the secondary reference was used to supplement the disclosure of the primary reference.

Hence, there are two requirements for using an additional reference to "enable" a primary reference in forming an anticipation rejection.

1. The primary reference must contain "every material element of the claimed invention"; and

2. The additional reference (a printed publication) is relied upon only to demonstrate that the claimed subject matter was in the possession of the public one year prior to the filing date of the patent application.

B. Sale of patentable subject matter outside of the United States is not a prior art "reference" and cannot be used to enable another reference under 35 U.S.C. §102(b).

It is elementary chemistry to realize that the disclosure of a compound's formula is enough to anticipate the claimed chemical formula because that formula is indeed the entire invention. The Samour and Donohue courts agreed that a secondary piece of prior art (a written publication) could be used to show the state of the art in the chemical field was in the public's possession. However, disclosure of the botanical name (and possibly a few other particulars) of a new and unanticipated asexually reproduced plant variety is not enough to anticipate a plant patent for the claimed variety.

In the present application, the Examiner relies on the sale of a variety named 'Penlava' in Germany as some type of "reference" that indicates what knowledge was in the public domain. However, the Samour and Donohue line of cases permits use of a true reference, an additional piece of prior art (a pre-application filing date publication), as evidence of the knowledge in the public domain. The sale of an invention outside the United States is not such a reference.

It is contrary to longstanding tenets of the patent laws to assert that sale of a claimed invention outside of the United States qualifies as a reference at all. The sale of a

variety named 'Penlava' outside the United States is not prior art. It is not a reference which is appropriate to use as evidence of the public's knowledge. An assertion that the sale of a claimed invention outside the United States as a reference (per Samour and Donohue) would vitiate the meaning of the on-sale bar of 35 U.S.C. §102(b).

If the Examiner's position is maintained, it would be changing the landscape of the patent law. Applicant appreciates the Examiner's recognition that a PBR application by itself would not be an enabled publication. Yet in essence, the Examiner is asserting that a non-enabling published description of a claimed invention combined with the sale of that invention outside of the United States would be enough to satisfy an anticipation rejection under 35 USC §102(b).

Such a position is untenable under United States law. By way of example, a simple (non-enabling) listing of a product (such as a computer) in a catalog or magazine published one year before an application for patent in the United States combined with the sale of that computer outside the United States more than one year before application date would be enough to bar patent protection in our country. Such an assertion is ludicrous and the ramifications are endless if the Board chooses to change precedent and decide that a PBR application combined with the sale of a geranium named 'Penlava' in Germany would be enough to bar patent protection in the United States.

III. Anticipation of plant subject matter

The cases of In re LeGrice, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) and Ex parte Thomson, 24 USPQ2d 1618 (Bd. Pat. App. & Inter. 1992) are consistent with Samour, Donohue, and Bristol-Myers and do not support a proposition that a non-enabling publication about a plant may be made enabling by public use or sale of the plant itself.

A. In re LeGrice

At issue in LeGrice was whether a published catalog listing a variety of rose plants along with some botanical data and a color picture thereof barred patenting of that rose variety as a plant patent. It was established on the record that the color picture in the prior art

catalog publication established identity at least in appearance between the rose plant illustrated in the catalog and the claimed variety.

1. A plant cannot be produced from a disclosure thereof in a printed publication.

In determining whether the catalog was an "enabling" disclosure, i.e., sufficient to give the public possession of the rose plant, the LeGrice court pointed out the following unique characteristics of plants as compared to manufactured articles. Plants protected by United States plant patents are asexually reproduced wherein the plant is propagated by divisions or cuttings to form clones, each of which is identical to its parent plant and to all other cuttings or clones taken from the parent plant. Id. at 937, 133 USPQ at 372. Even when the parentage of the claimed variety is set forth in a publication, no two seeds produced by cross-pollinating the parent plants can be expected to produce identical plants. Id. at 938, 133 USPQ at 373. The principles of heredity and plant genetics introduce innumerable possible combinations of genetic material which may result in equally innumerable distinct plants. Id.

The impossibility of producing a particular variety from a description thereof in a printed publication was a critical factor for the court in LeGrice. The court emphasized that the description of the invention in the printed publication must be an "enabling" description and that the proper test of an enabling description in a publication as a bar to a patent under §102(b) is "whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought'. Id. at 939, 133 USPQ at 374.

To put an invention in possession of the public based on a printed publication, the description therein must be:

> so precise and particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill.

Id. at 933, 133 USPQ at 369.

In 1962, the LeGrice court recognized that the knowledge of plant genetics made it impossible to reproduce a particular plant having specific botanical characteristics based solely on a description of the plant, even when the parent plants were known. Despite the many advances in biotechnology over nearly 40 years, that limitation on reproducing plants holds true.

Please find enclosed a Declaration by Dr. Richard Craig, an expert in the field of horticulture, as Attachment A. The details of Dr. Craig's Declaration are not repeated herein, but should be appreciated for the explanation of the differences between asexually reproduced plants and sexually reproduced plants and the impossibility of generating a desired plant from a description thereof in a printed publication. As detailed in Dr. Craig's Declaration, there is no possibility of recreating a particular variety via experimentation because of the endless possibilities when the genes of parent plants are combined to produce daughter plants.

> Thus, when one makes a cross-fertilization of heterozygous parents, one cannot predict the specific combination of traits in the progeny. When a large number of genes have different allelic combinations in the parents, the possible genotypic combinations in the hybrid progeny approach infinity.

Craig Declaration at page 3.

Dr. Craig states that a description of a plant (such as the description in a PBR) cannot be used to recreate the plant.

> Starting only from a photograph or a written description of a particular cultivar, a plant breeder cannot reproduce the cultivar. No person can independently create through fertilization and hybridization the exact genetic replica of another plant.

Craig Declaration at page 4.

Thus, it is still true today that a description of a particular variety cannot enable one skilled in the art to recreate that variety.

In the decision below LeGrice, the Board of Appeals reasoned that since a description of a plant in a plant patent application is deemed sufficiently enabling to grant a patent, then a publication on a plant should be considered equally enabling to bar patenting. The LeGrice court pointed to two errors in that reasoning. First, §162 specifically permits varying degrees of description in a plant patent while §102(b) makes no such allowance regarding the sufficiency of the description in an anticipatory printed publication. Therefore, a plant patent application may be less specific than an anticipatory publication. Second, §163 does not grant a right to exclude others from "making" a claimed plant but only to exclude others from asexually reproducing or selling the claimed plant. The statute reflects the reality that "there is no possibility of producing the plant *from a disclosure* as 35 U.S.C. § 112 contemplates" because one cannot make a plant, only asexually reproduce or sell it. Id. at 944, 133 USPQ at 378.

2. The description of a plant and identification of a source to obtain the plant outside the United States is not prior art under 35 U.S.C. §102(b) in a plant patent application.

In the present case, the Examiner has asserted that LeGrice is not controlling because it did not specifically address the issue of enablement of a printed publication on a plant variety by sale of that plant outside the United States. However, as detailed below, the appeal in LeGrice actually did address an issue of commercial availability of a plant outside the United States.

3. The LeGrice decision contains significant evidence of public distribution of the rose varieties.

The Appellant of LeGrice, (Mr. Edward Burton LeGrice) filed plant patent applications in the United States in 1958 on two rose varieties, Charming Maid and Duskey Maiden. More than one year before the filing dates, both varieties were listed in the National Rose Society Annual of England and in catalogs. Those publications are compelling evidence of public use or sale of the varieties in England.

The Rose Annual of 1949 stated that Dusky Maiden, "raised and exhibited by E.B. LeGrice", received "The Gold Medal Award". Id. at 931, 133 USPQ at 368. An

award-winning plant undoubtedly was exhibited to rose breeders and other skilled artisans. Certainly, Dusky Maiden was publicly used in England by 1949.

The Rose Annual of 1954 contained information on Charming Maid including listing the following: "Raiser and Distributor E.B. LeGrice, Note Walsham". Id. at 932, USPQ at 368. According to the 1954 Rose Annual, Charming Maid was distributed by Mr. LeGrice. Distribution (via a sale or other public activity) of Charming Maid occurred in England more than one year before the United States filing date.

Both Dusky Maiden and Charming Maid were described and shown in catalogs with color photographs thereof establishing identity in appearance between the varieties in the catalogs and the varieties of the United States plant patent applications. *Id.* Presentations of the varieties in a catalog is also compelling evidence of their status of having been offered for sale in England.

Despite all this evidence of sale and/or public use of Dusky Maiden and Charming Maid by Mr. LeGrice in England, the appeals court did not specifically address any issue of such activity presumably because it occurred outside the United States.

4. The record of the appeal in LeGrice shows that the sale and/or public use of the two rose varieties was disposed by the Board.

There was no discussion about enablement of the printed publication based on public availability of the rose in the LeGrice decision reported by the CCPA because the issue of public availability of the roses outside the United States was disposed of in the lower decision at the Board of Appeals. See, Application of Edward Burton LeGrice, Decision of Board of Appeals, February 12, 1960 (attached hereto as Attachment B and hereinafter referred to as the "Board LeGrice Decision").

In the appeal to the Board by Mr. LeGrice, the Board correctly recognized that the "use or sale of the plants in a foreign country would be irrelevant" to the issue of novelty. Id. at page 25. Moreover, the Board found evidence of foreign sale and/or public use of the rose varieties.

> The publications indicated that the particular plants were on sale, and presumably also in public use, more than one year

> prior to the respective filing dates of the applications since appellant is indicated as 'raiser and distributor'. However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. The single broad issue of the competency of a prior printed publication to bar a plant patent is presented.

Id. at page 22.

Hence, the LeGrice court had plenty of evidence of commercial availability of the rose varieties outside the United States, and the stated presumption was that the plant was in public use. It did not directly address those facts since they were irrelevant to the novelty of the plant under United States statutory law and had been properly dispensed with by the Board of Appeals.

5. A publication is incapable of placing a plant variety in the public domain.

The LeGrice court focused on whether the publications (the Rose Annuals or the catalogs), when interpreted in light of the knowledge possessed by plant breeders, placed the rose varieties in the public domain. Importantly, when the court looked to what constituted the knowledge possessed by plant breeders, it did not even consider the evidence of prior use and/or sale of the rose varieties. The Board had dismissed any relevance of that evidence to the issue of novelty of the rose varieties in the United States.

Instead, the standard applied by the LeGrice court for the enablement of a publication under 35 U.S.C. §102(b) is whether "a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention". LeGrice at 936, 133 USPQ at 372. The "knowledge" for a skilled artisan was not -- and still is not -- the commercial activity of the breeder outside the United States.

The "knowledge" of the skilled plant breeder includes plant genetics. In 1962, the knowledge of plant genetics meant that publications (such as the Rose Annuals and catalogs) could not be relied upon as statutory bars under 35 U.S.C. §102(b). The LeGrice court cautioned, however, that each case must be decided on its own facts and that future studies may add to "the knowledge of plant breeders so that they may *someday* secure

possession of a plant invention by a description in a printed publication". Id. at 939, n. 7, 133 USPQ at 374, n. 7.

There can be no dispute; that "someday" has not yet arrived.

6. The facts of LeGrice, non-enablement of a plant patent claim by a description of the plant, parallel the present case.

In both LeGrice and here, the material elements of a plant patent claim are not set forth in the printed publication and there is no need to consult additional references, nor is it appropriate to do so.

A PBR application which refers to a species of a plant, a plant name and a few bits of botanical data cannot be considered to be so "precise and particular" that a skilled artisan could "construct and operate it without experiments and without further exercise of inventive skill". The ability to purchase a geranium named 'Penlava' one year prior to the application filing date is not equivalent to the ability to "construct and operate" a new geranium variety named 'Penlava' based on the PBR application. One skilled in the art may have learned of a geranium named 'Penlava' – outside the United States. While public prior use and sale are avenues by which a plant enters the public domain, that prior use or sale must have occurred in the United States to rise to the level of a statutory bar. See 35 U.S.C. §102(b).

A PBR application could lead one skilled in the art to find a plant to purchase outside the United States which bears a name mentioned in the PBR application. That scenario is not one which renders the PBR application enabling. It is simply a trail which leads to a sale of a plant outside the United States. There is no support in LeGrice or elsewhere for the proposition that sale of a named plant outside the United States automatically enables the publication of a PBR application listing a plant with the same name.

B. Ex parte Thomson

Naturally, a different result was found in Ex parte Thomson when the claims in a utility application for a cotton cultivar were rejected over a prior art reference which

identically disclosed the specification of the application for the cotton cultivar. The rejected claims were as follows:

1. A cotton cultivar having the designation Siokra (ATTC 40405).

2. Seeds of the cotton cultivar according to Claim 1.

The Board of Patent Appeals and Interferences found that several prior art references disclosed the exact same cotton cultivar and seeds of that cultivar. Importantly, the Board found that "for enablement purposes, the descriptive words of the specification herein do not differ substantially from the disclosures of the cited publications". Id. at 1621 (emphasis added). Moreover, the specification of the utility application was enabled by the availability of the claimed seeds deposited in the American Type Culture Collection (ATTC). The cited publications were also enabled by the public availability of the same cotton seeds. Id. As such, the public accessibility of the claimed seeds would have enabled the skilled artisan to make and use the claimed cotton cultivar and its seeds. Id. The Board upheld the rejection of the claims under 35 U.S.C. §102(b) based on (1) prior art references that identically disclosed the claimed cultivar and (2) the opportunity for a skilled cotton grower to read the prior art references, purchase the commercially available seeds, and employ conventional techniques to obtain the claimed invention, namely, the plants and its seeds.

The Board distinguished LeGrice for three reasons.

First, actually following LeGrice, it recognized that each case is decided upon its own facts in determining whether the description in a printed publication is "adequate to put the public in possession of the invention and bar patenting of a plant" under §102(b). Id. at 1620. The Board believed that sufficient advancements in plant eugenics warranted not following LeGrice's rule on non-enablement of publications and expressed no doubt that the skilled artisan would be able to grow the claimed cultivar. As detailed in Dr. Craig's Declaration, the Board was clearly mistaken. The "someday" of securing a plant invention by a description in a printed publication has not yet arrived. Regardless of the Board's erroneous comments on genetic technology, it remains axiomatic that each case must be decided on its own facts. Id.

Moreover, the Thomson Board clearly misunderstood the evidence of commercial availability of the rose varieties in LeGrice by stating that:

> [LeGrice's] holding was based on the specific "printed publications" before it, and no indication was given that the "prior catalogue publication" before it evidenced commercial availability in a readily enabling form. The court simply stated that the prior catalog publication "includes a color picture of the rose clear enough to establish identity in appearance between the rose illustrated and applicants variety".

Thomson, 24 USPQ2d at 1621.

As detailed above, the LeGrice decision is replete with evidence of public use and/or sale of the rose varieties outside the United States. The irrelevance of those activities was disposed of by the Board.

Second, the Board found it significant that for enablement purposes the descriptive words of the specification did not differ substantially from the disclosures of the cited publications. Id. In other words, all the material elements of the claim were disclosed in the primary reference. The specification was enabled by the deposit of the claimed seeds and the cited publications were also enabled by the deposit of the same seeds. The court noted that LeGrice did not consider the public availability of the rose plant at issue therein, and that the LeGrice holding was based on the specific printed publications. Public availability of the plant was one factor in the Thomson decision because the claim itself was enabled by public availability of the plant. However, a "significant" aspect of the 102(b) rejection was that the descriptive words of the prior art references did "not differ substantially" from the disclosures of the specification. Id.

Finally, the Board pointed out that whereas LeGrice was directed to patentability of plant patents, the patent at issue in Thomson was a utility patent which is afforded a broader scope of protection. Id. at note 1. Hence, the standard for anticipation by a printed publication is to be more broadly applied to the claims in a utility application than to a claim in a plant patent application. Id.

The Office Action in the present case incorrectly asserts that the same question was asked in Thomson and LeGrice of "what is required to enable" a printed publication describing a plant. The questions in those two cases must be different because Thomson involved a utility patent claim and LeGrice involved a plant patent claim -- and those are two different forms of statutory subject matter having different standards for enablement and infringement.

It should be understood that the Thomson decision is consistent with Donohue and Samour in meeting the requirements for using additional references in a §102(b) rejection.

First, every material element of the Thomson claim was set forth in the primary reference. ("We find it significant for enablement purposes the descriptive words of the specification do not differ substantially from the disclosure of the cited publications"). Thomson, 24 USPQ2d at 1621.

Second, the additional "reference" (the publicly available seeds) was cited solely to show that the plant described fully in the primary reference was in the public domain. As was true for Samour and Donohue, the Thomson rejection did not combine teachings of two references. The added reference only demonstrated that the plant material fully described in the primary reference was in the public domain.

IV. Enablement of a PBR publication as a prior art reference is inconsistent with past and current examination practices in plant patent applications.

The standards for compliance with 37 C.F.R. §1.163 and 35 U.S.C. §112, first paragraph in plant patent applications have become increasingly strict. Despite the variance in the degree of description in a plant permitted by 35 U.S.C. §162, recent experience shows that many disclosures of plant patent applications are objected to and the claims therein are rejected under 35 U.S.C. §112 first and second paragraphs which require as follows (emphasis added):

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to **enable** any person skilled in the art to which it pertains, or with which it is

> most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The October 2, 2003 Office Action in the present application included an objection to the disclosure under the first paragraph of §112 and a rejection of the claim under the first and second paragraphs of §112 for asserted lack of "a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents".

Historically, the United States Patent and Trademark Office has not considered the information in a PBR application sufficient under §§112 and 162. More recently, even significantly more complete disclosures (such as the original specification filed herein) are not considered to be sufficiently complete (not enabling) under the statute.

To now assert that a PBR application somehow is enabling prior art (alone or in combination with sale or use outside the United States) is inconsistent with the examination practice of requiring detailed botanical information in plant patent applications. The United States Patent and Trademark Office cannot have it both ways of asserting a PBR application as enabling prior art and rejecting reasonably detailed plant patent applications for lack of enablement. Moreover, this new interpretation of PBR applications as being enabling prior art is contrary to decades of plant patent examination policy and practice.

Future plant patent applicants can comply with the stricter interpretation of §162 when submitting their applications, but they should not be faced with a prior art rejection based on a non-enabling PBR document.

VIII

THE REALITIES OF PLANT BREEDING

Time delays in breeding new plant varieties exist whether the breeding occurs in the United States or elsewhere. In the case of plants bred outside the United States,

additional testing and trialing in the United States must take place to make sure the new plants are adaptable to the climatic conditions in this country. This often takes several years before the plants are deemed acceptable and actually enter the United States market. Only a few varieties tested and trialed in the United States actually enter the United States market, and it is not economically feasible to file immediately on every variety to be tested. The new patent policy requires that such immediate filing take place thereby placing the foreign plant patent breeder at a distinct economic disadvantage.

A plant bred in Germany can be introduced much more quickly in Germany because it was bred and grown there from the outset. Therefore, there is often a sale in Europe more than one year before the United States plant patent application is filed. A sale outside the United States does not trigger a statutory patent bar and does not diminish the need to afford protection to foreign plant breeders seeking to introduce their horticultural developments into the United States.

This concept has been understood since at least the time that the Townsend-Purnell Plant Patent Act become law in 1930. The Plant Patent Act of 1930 was enacted "to afford agriculture, so far as practicable, the same opportunity to participate in the benefits of the patent system as has been given industry". H.R 1129, 71st Congress, 2d Session (1930).

> Today the plant breeder has no adequate financial incentive to enter upon his work. A new variety once it has left the hands of the breeder may be reproduced in unlimited quantity by all. The originator's only hope of financial reimbursement is through high prices for the comparatively few reproductions that he may dispose of during the first two or three years. After that time, depending on the speed with which the plant may be asexually reproduced, the breeder loses all control of his discovery. Under the bill the originator will have control of his discovery during a period of 17 years, the same term as under industrial patents. If the new variety is successful, the breeder or discoverer can expect an adequate financial reward.

Id.

Under the current examination practice, rejection of plant patent applications by foreign breeders who have not yet introduced their discoveries into the United States cuts off their opportunities of reaping adequate financial reward in the United States. Plant varieties which are not ready for introduction into the United States, but were sufficiently

developed in Europe to be introduced there, are not given the benefit of the patent system as was intended by the Plant Patent Act of 1930. Without that benefit, foreign plant breeders "only hope of financial reimbursement is through high prices for the comparatively few reproductions that [they] may dispose of during the first two or three years" following introduction of varieties into the United States. Id. The Plant Patent Act of 1930 was adopted so that "plant patents will mean better agricultural products that will give the public more actual value for its dollar". Due to the current rejection policy and to the detriment of the public, advances in agriculture made outside the United States may not reach this country.

This policy by the United States Patent and Trademark Office represents a radical departure from any previous policy in the area of plant patent law. It has been estimated that under such a radical policy, 70% of the extant plant patents issued to foreign applicants in the United States are invalid.

Relying on use and sales outside the United States to turn a non-enabling plant disclosure into an enabling one was never contemplated by drafters of the Plant Patent Act, is not recognized by statute, is contrary to Patent Office policy from at least as early as the LeGrice decision (1962) and makes absolutely no sense to anyone skilled in the art. This new radical policy needs to be promptly reversed so foreign plant breeders again have opportunities in this country to file United States plant patent applications.

IX
CONCLUSION

In the absence of disclosure of every material element of the claimed subject matter, the PBR documents fail to meet the anticipation requirements of 35 U.S.C. §102(b). The sale of the claimed variety outside the United States more than one year prior to the filing date of the United States patent application can be relied upon only to show that the claimed subject matter was in the possession of the public and not to supplement the impossibility of a PBR application to disclose every material element of the claimed invention.

The plant patent examining group has created a new position on prior art to plant patent applications that is counter to decades of examination. This policy, if not withdrawn, will have the effect of essentially blocking United States plant patents on plant varieties discovered in foreign countries. It represents the ultimate disservice to the foreign breeder.

This new position has no basis in fact or in law and is based in part on a false premise, namely, that LeGrice did not deal with sale in a foreign country. According to statute, the sale puts the variety in a certain public domain, but not the public domain which constitutes a statutory bar - it is not "in this country" as required by 35 U.S.C. §102(b). Moreover, the "someday" of plant genetics from LeGrice has not arrived. A printed publication cannot bar patenting of a plant because a plant variety cannot be created from a description of the plant.

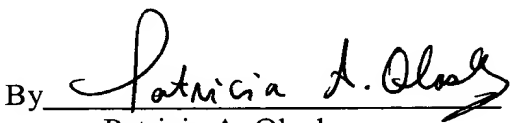
The only §102(b) bar to plant patent applications is the sale, offer for sale, or public use of the plant itself within the United States. Likewise, the invention of a plant patent is the plant itself. A plant patent can have but one claim -- to the plant itself. Plant patent infringement requires proof that the infringing plant is an asexually reproduced progeny of the parent plant -- it requires access to the plant itself. Imazio Nursery, Inc. v. Dania Greenhouses, 69 F.3d 1560, 36 USPQ2d 1673 (Fed. Cir. 1995).

It follows that the plant itself must be present in the United States to bar novelty under §102(b). The asserted enablement of a printed publication by "non-prior art" (sale outside the United States) is an attempt to thwart the statutory requirement that the plant itself be present in the United States to bar a plant patent in light of today's understanding of plant genetics. The anticipation rejection should be withdrawn.

A check in the amount of $500.00 accompanies this Appeal Brief. The Commissioner of Patents and Trademarks is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650. Please refund any overpayments to Deposit Account No. 23-0650. An original and two copies of this Appeal Brief are enclosed.

Respectfully submitted,

THE WEBB LAW FIRM

By 

Patricia A. Olosky
Registration No. 53,411
Attorney for Applicant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818
Telephone: (412) 471-8815
Facsimile: (412) 471-4094
E-mail: webblaw@webblaw.com

APPENDIX A
CLAIMS APPENDIX

I Claim:

1. A new and distinct variety of geranium plant substantially as described and illustrated herein.

APPENDIX B
RELATED PROCEEDINGS APPENDIX

Please find enclosed a copy of each decision rendered by the Board or the Court of Appeals for the Federal Circuit (CAFC) identified pursuant to 37 C.F.R. §41.37(c)(1)(ii).

DECLARATION

I, Richard Craig, Ph.D., declare as follows:

1. I have Bachelor of Science and Master of Science Degrees in Horticulture and a Ph.D. Degree in Genetics from the Pennsylvania State University.

2. I have been a member of the faculty, currently as a Professor of Plant Breeding and The J. Franklin Styer Professor of Horticultural Botany, at The Pennsylvania State University for 39 years.

3. I am the inventor or co-inventor on two Utility Patents and 24 Plant Patents on Pelargonium. A complete list of my publications and patents is attached hereto.

4. The following definitions are provided for reference herein:

   A **diploid** is an organism with one pair (two copies) of cytologically identical chromosomes that can pair during prophase of meiosis. Diploids of most organisms exhibit Mendelian (disomic) inheritance. Inbred lines are easy to produce and seed production of inbred cultivars and F1 hybrids are generally possible assuming no barrier to self- or cross-fertilization.

   Haploid refers to the gametic chromosome number of a diploid organism. A haploid contains one-half of the number of chromosomes of the parent. In a diploid organism the haploid chromosome set is termed a **genome**; thus all of the genetic information that is representative of the organism is contained in a single genome.

   A **polyploid** is an organism with more than one pair of each chromosome i.e., three, four, five, six or more of each chromosome is present; these chromosomes may or may not be cytologically identical. A polyploid may also be a plant of any of the above configurations that lacks or has extra individual chromosomes.

   An **autotetraploid** is an organism with sets of four cytologically identical chromosomes that can pair during prophase of meiosis.

   The **flower** is the site of all reproductive events in higher plants. Stamens include anthers that are the site of pollen formation. The pistil (stigma, style and ovary) is the site of maternal gamete formation. **Pollination** is the transfer of pollen from an anther to a stigma; **fertilization** is the process of gametic union.

5. A **sexually reproduced plant** is one that is produced from seed derived from the process of double fertilization in which a maternal egg cell (haploid) is fertilized by a paternal sperm cell (haploid) forming the diploid zygote. In a second fertilization, two fused haploid

maternal (polar) cells are fertilized by a haploid sperm cell forming the triploid endosperm, which ultimately serves as a nutritional resource for embryo development and/or subsequent germination events.

The maternal gamete is produced in the ovule of the pistil of the flower and more specifically in the embryo sac that is connected to the maternal tissue at a site called the placenta. The products of the ovule are derived from the maternal (also known as seed, pistillate, female) parent. The most internal tissue of the embryo sac contains the megaspore mother cell. The megaspore mother cell undergoes meiosis to form four haploid megaspores; three of these megaspores disintegrate and the remaining megaspore undergoes endomitotic divisions to form an eight-nucleate (other variations are possible) embryo sac. These nuclei/cells assume specific positions in the embryo sac and three of the nuclei, including the egg cell and two polar cells, are defined by their position.

Pollen is produced in the anthers of the stamens of the flower. Pollen utilized in double fertilization can be derived from either the same parent that contributes the egg (self-fertilization), or from a genetically distinct, unrelated plant (cross-fertilization). The sperm cells are produced from pollen (microspore) mother cells via meiosis to form four microspores, a successive endomitosis to form the vegetative and generative cells, followed by an amitosis to form the two sperm cells.

The zygote undergoes successive mitotic cell divisions to form an embryo. The embryo and endosperm are contained within the embryo sac. The embryo sac is enclosed within one or two integuments; these ultimately become the seed coat (testa). The entire structure is called the ovule; thus a seed is a mature (ripened) ovule

6. **Inbred lines** are normally produced through self-fertilization either of naturally self-fertilized species or through controlled self-fertilization of normally cross-fertilized species. During the process of inbred line development, progeny may be selected for desirable traits of commercial and/or scientific interest. The final seed-produced progeny are uniform for these traits.

Self-fertilization leads to genetic homozygosity (uniformity of alleles at a gene). With each generation of self-fertilization, heterozygosity of plants and genes (each and all genes) is decreased by 50%; conversely homozygosity is increased proportionally. After a certain number (5-7) of generations of self-fertilization, homozygosity of loci and plants approaches 100 % and progeny are phenotypically uniform for most traits.

Breeding progress (with the exception of homozygosity) may be impeded or affected by such phenomena as selection, epistasis (interaction of at least two genes affecting a single trait), linkage (genes segregating together), cytoplasmic inheritance (maternal or paternal influences are not caused by nuclear genes but by genetic elements in chloroplasts or mitochondria), and environmental influences.

Inbred lines may be used as parents of F1 hybrid cultivars. Inbred lines may also be used for inheritance as well as gene mapping studies.

It is crucial to recognize that not all species can be self-fertilized (or continually self-fertilized), that is, in many species inbred lines are not possible either commercially or scientifically. Reasons for lack of ability to self-fertilize may be dioecy (maternal and paternal gametes produced on separate plants), inbreeding depression (the loss of vigor or fertility due to self-fertilization), self-incompatibility (viable pollen which is incapable of fertilizing a plant with similar "incompatibility" alleles), or various gametic and/or zygotic sterilities. In these cases only cross-fertilizations are usually possible.

7. An **F1 hybrid** is the sexually reproduced progeny developed from the cross-fertilization of two inbred parents (true breeding and genetically homozygous for traits of commercial and/or scientific interest). The parents usually have different genetic (allelic) constitutions and the F1 hybrids are heterozygous for all genes that are polymorphic between the two parents. In contrast to the genetic heterozygosity of F1 plants, the progeny thereof are homogeneous in appearance because they share the same genetic constitution. Conversely F1 hybrids will not produce uniform progeny upon self- or cross-fertilization. All genes that are heterozygous in the F1 hybrids (polymorphic between the original parents) segregate in the succeeding generations. Once an F1 hybrid is created, it may also be asexually propagated and cloned.

8. The term **hybrid** can be applied to any sexually reproduced progeny resulting from the cross-fertilization of two or more parents regardless of the origin or genetic constitution of those parents. The parents may be of different genera (intergeneric hybrids), different species (interspecific hybrids), different botanical varieties (intervarietal hybrids), different cultivars, different breeding lines, etc. Hybrids result from double fertilization with the sperm cells (pollen) contributed by one parent and the egg cells contributed by a second parent. With the exception of F1 hybrids and inbred lines, cross-fertilization and indeed self-fertilization of most plants produces heterozygous and heterogeneous progeny. In most instances, every progeny will be different from every other both genotypically (genetic constitution) and phenotypically (traits).

   This non-uniformity is normal in species that are **diploid.** Thus, when one makes a cross-fertilization of heterozygous parents, one cannot predict the specific combination of traits in the progeny. When a large number of genes have different allelic combinations in the parents, the possible genotypic combinations in the hybrid progeny approach infinity.

   Such genotypic diversity among hybrids is magnified when species are **polyploid** - having more than two identical genomes. Thus, each gene is present in more than two copies leading to an exponential number of phenotypes in the progeny. Many fruit and ornamental plants are polyploid in origin and indeed are polyploid in cultivation. This polyploidy often is accompanied by positive phenotypic characteristics such as larger fruit, improved keeping quality, etc. When these species are cross or self-fertilized, they produce highly heterozygous and heterogeneous progeny. The possible combination of genes is infinite.

   For these reasons, polyploidy and genetic heterozygosity, many cultivars can only be propagated (replicated, cloned) through asexual processes for commercial production.

9. An **asexually reproduced plant** is produced from cells, tissues, or organs of a mother plant without the process of fertilization. Asexual propagation may occur through cuttings with adventitious roots, physical divisions, runners, layering, grafting, tissue culture, bulbs, corms, tubers, adventitious embryony, and apomixis. Adventitious embryony is the production of embryos from somatic tissues; these are entirely maternal in origin and genetic constitution. Apomixis (parthenogenesis) is the asexual production of seed from solely maternal tissues via specialized processes. When a single progeny or an infinite number of progeny are asexually produced directly from a single mother plant, this is defined as cloning and the progeny are termed clones. With the rare exception of somatic mutations all clones share the same genetic constitution, and are exactly identical to the mother plant.

10. Starting only from a photograph or a written description of a particular cultivar, a plant breeder cannot reproduce the cultivar. No person can independently create through fertilization and hybridization the exact genetic replica of another plant.

Without access to the actual desired plant (or an actual plant of an inbred cultivar or the inbred parents of an F1 hybrid cultivar), the only route to recreating the particular cultivar is to self- or cross-fertilize various parental plants until the desired genotype is somehow recreated. The number of combinations of genes and resulting genotypes from hybridization of diverse parents approaches infinity. Even when the parents of the desired cultivar are known (i.e. the starting materials for recreating the cultivar are known), hybridization thereof still involves the potential for essentially infinite combinations of genes. Hence, such an attempt to recreate a particular cultivar is futile.

11. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Richard Craig

Richard Craig, Ph.D.

1/5/02

Date

22 APPLICATION OF EDWARD BURTON LEGRICE

28 Decision of Board of Appeals, February 12, 1960

The above identified applications involving the identical legal question are being considered simultaneously on appeal. Each is an application for a plant patent having the customary single formal claim which in each case is directed to an assertedly new variety of rose plant.

In each case descriptions of the plant have appeared in printed publications more than one year prior to the filing of the applications. These have appeared, for one case, in The National Rose Society Annual of England
29 for 1949 and for the other case in The National Rose Society Annual of England for 1954 (the applications were filed in 1958). Photocopies of pages of these Annuals are of record. In each case there are also catalogues published more than one year prior to the dates of the respective applications. The catalogues have not been made available but are admitted, pages 24 and 23 of the respective briefs, to "add to the information in the Rose Annual a reproduction in color of a color photograph of the variety."

In a paper filed November 19, 1959 in Appeal No. 269-46 requesting consolidation of the two appeals, appellant conceded that "the publications are thoroughly adequate in each instance to identify the plant as the plant in the particular application." A similar statement appears on page 3 in each of the reply briefs.

It may be noted that the various publications were acknowledged by appellant in the oaths accompanying the applications.

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing dates of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. The single broad issue of the competency of a prior printed publication to bar a plant patent is presented.

The examiner has rejected the claim in each case on the ground that the printed publications having effective dates more than one year prior to the filing dates of the instant applications constitute statutory bars to the grant of patents on the described varieties of rose plants. The applicable portion of 35 U. S. C. 102(b) reads:

"A person shall be entitled to a patent unless—

* * *

(b) the invention was . . . described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States, . . ."

The examiner held the above provision applicable to plant patents in view of Chapter 15—Plant Patents of the U. S. Code Title 35—Patents, which in section 161 states:

"The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided."

Appellant (bottom of page 13 of brief) recognizes that the plant patent act was "engrafted onto the existing patent laws" and their provisions, except for "greater liberality in the completeness of the disclosure," made applicable to plants. He states:

"There was no intent to change the meaning of the wording such as now included in the quoted paragraph 102 (b), as theretofore applied to patents on articles, machines, methods, and the like. There is no evidence that it was intended that these words were to be interpreted differently in connection with plants."

It is evident from the preceding that appellant does not challenge the point so vigorously stressed by the examiner, namely the applicability of 35 U. S. C. 102(b) to plant patents The premise of this appeal is simply that a publication describing a plant cannot, no matter how

31 complete, enable anyone to practice the invention (produce the plant); consequently such publication can never bar a plant patent under 35 U. S. C. 102(b). This result is said to follow from a consideration of the standard applied in patents for inventions, namely that in order to defeat such patents the printed publication advanced as a bar must be sufficient to enable one skilled in the particular art concerned to practice the invention, i.e., to produce the final useful result; Wisconsin Alumni Research Foundation *v.* George A. Breon & Co., 30 USPQ 242, 85 F. (2d) 166, CCA 8 (1936); Dewey & Almy Chemical Co. *v.* Mimex Co., Inc., 52 USPQ 138, 124 F. (2d) 986, CCA 2 (1942); or knowledge of the article describing would teach a skillful mechanic some process of making it; Cohn *v.* Corset Co., 93 U. S. 366, 23 L. Ed. 907 (1876); *In re* Schaeffer, 2 App. D. C. 1, 8 (1893). Since neither of these requirements is met by a published description of a plant it is contended such publication must by application of the same standard be held insufficient to bar the grant of a patent on the plant.

The examiner, while not seriously challenging the appellant's premise that a plant description cannot enable anyone to produce the plant (nor do we see any reason for questioning this premise), states that the language of the statute must be taken in its exact and unequivocal meaning otherwise the anomaly arises that plant publications must be totally ignored as printed publications. In fact, it would have the effect of wholly eliminating that particular provision from 35 U. S. C. 102(b) in the case of plant patents. The examiner further maintains that a prior description of an existing plant adequate to identify the plant
32 claimed would negative patentable novelty as not "a distinct and new variety" (35 U. S. C. 161).

As indicated by his reply brief the most that appellant would concede with respect to the effect of such publication is that it might constitute secondary evidence of the *prior existence* of the actual plant and *sale* thereof so as to constitute a statutory bar. He further suggests that this

secondary evidence could almost be accepted with little or no corroboration because the chances of any fraud on the public are extremely remote. As has been stated the use or sale of the plants in a foreign country would be irrelevant.

Appellant contends it is absurd to hold that in one case (mechanical) a disclosure must be an enabling disclosure while in another (plant) it need not be. The examiner's "strict literal interpretation" above is (page 13 of brief) alleged to defeat the intent of the plant patent law which is to reward practical results and perpetuate the thing patented after expiration of the patent. Since no one could produce the plant from a written description it is alleged that this result can be assured only by grant of a patent which in turn would encourage the inventor to distribute the plant widely and thereby minimize the possibility of its loss or destruction. With respect to the remark concerning absurdity, it is no more absurd to use a disclosure which is not enabling as a bar than it is to grant a patent on such a disclosure; the disclosure in the specifications of these applications are admittedly just as unenabling as the disclosures of the publications as page 9 of the brief states that:

33 "The teaching in plant patent cases . . . cannot enable anyone, even the most skillful of plant breeders, to produce the particular plant."

Upon consideration of the issue here presented we have come to the conclusion that the examiner must be sustained. Concerning the alleged need for an enabling disclosure to constitute an anticipation, we direct attention to the fact that in the case of claims to an article (or compound), which a claim for a plant is admitted (page 8 of brief) to be most nearly like, disclosure of an operative method of making such article is not essential to constitute an anticipation. On this point we think appellant has misinterpreted the case law. Cohn *v.* U. S. Corset Co., *supra*, relied upon by appellant did not require in the reference a

teaching of how to make the article. The Court of Appeals of the District of Columbia in the later decision *In re* Decker, 1911 C. D. 274, 162 O. G. 999, 36 App. D. C. 104, quoted Cohn *v.* U. S. Corset Co. as authority for the proposition that the inoperativeness of the reference procedure was immaterial to a consideration of the patentability of the article. A complete description of the article in the reference was held to be all that was required to defeat claims to such article. This ruling was followed in *In re* Marden & Rentschler, 18 CCPA 1119, 1931 C. D. 334, 409 O. G. 561, 48 F. (2d) 428, 8 USPQ 515, in an application involving claims for a ductible thorium wire.

That this principle remains controlling law will be evident from the more recent decisions. See for example *In re* Attwood, 45 CCPA 824, 1958 C. D. 204, 730 O. G. 790, 253 F. (2d) 234, 117 USPQ 184, involving claims to U-shaped metallic channel member as a concrete insert.

24 The Court of Customs & Patent Appeals there stated:

> ". . . it is well settled that where the article claimed is disclosed in a prior patent, the claim may be rejected on that patent notwithstanding the fact that the process by which the patentee claimed the product could be produced is inoperative. *In re Marden and Rentschler,* 16 C. C. P. A. (Patents) 1119, 48 F. 2d 423, 8 U. S. Pat. Q. 515; *In re Von Bramer et al.,* 29 C. C. P. A. (Patents) 1018, 1024, 127 F. 2d 149, 53 USPQ 345. Clearly, appellant can stand in no better position where the patentee discloses no process for making the article claimed or where appellant can not discern from the patent disclosure how to construct the article as disclosed."

In *In re* Crosley et al., 34 CCPA 882, 1947 C. D. 216, 600 O. G. 172, 159 F. (2d) 735, 72 USPQ 499, the same court stated:

> "Furthermore, this court is committed to the doctrine that where a product is clearly disclosed in a

publication, the operativeness of any of the processes by which it is claimed the product could be produced is immaterial, and that the disclosure of the composition is sufficient to anticipate a claim therefor."

The U. S. Court of Appeals, District of Columbia Circuit still follows the same rule. See for example Merck & Co., Inc. v. Marzall, 1952 C. D. 35, 661 O. G. 576, 197 F. (2d) 206, 93 USPQ 355, wherein this court stated:

"We are dealing solely with an application for a patent on the compound itself. Such an application must be denied if there has been any prior disclosure of the compound, even though no practical means for its isolation or manufacture was previously known. R. S. 4886, 35 U. S. C. § 31; *Eastman Kodak Co. v. Coe*, 78 U. S. App. D. C. 403, 135 F. (2d) 336."

Since appellant has admitted that the reference publications in these cases adequately identify the claimed plants it follows from these holdings that the appealed claims were properly rejected regardless of the question of sufficiency of the reference disclosures as to how to produce the plants. The decisions demonstrate that there is no inconsistency in this instance between what properly constitutes a publication under 35 U. S. C. 102(b) in mechanical cases (patents for inventions) and the examiner's application of the references to the claims in the instant plant patent cases.

The decision of the examiner is affirmed.

AFFIRMED

L. P. McCANN)
Examiner-in-Chief)
)
P. J. FEDERICO) BOARD
Examiner-in-Chief) OF
) APPEALS
N. A. ASP)
Examiner-in-Chief)

APPENDIX B

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WILHELM ELSNER

Appeal No. 2003-0841
Application No. 09/664,247

HEARD: March 26, 2003[1]

Before WINTERS, WILLIAM F. SMITH, and ADAMS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision in an appeal under 35 U.S.C. § 134 from the examiner's final rejection of the claim pending in this plant patent application. We affirm.

BACKGROUND

The present invention relates to a geranium named Pendec. Pendec is a spontaneous mutation of "Pendresd" and is asexually reproduced. Specification, page

[1] This appeal was heard in conjunction with Appeal No. 2003-0703, plant patent Application No. 09/267,559 and Appeal No. 2003-0704, plant patent Application No. 09/286,130. See Petition Under 37 CFR § 1.182, filed February 3, 2003, (Paper No. 15) and Request for Special Handling (Part of Paper No. 17). The three appeals have been decided concurrently.

1. There came a time when the owner of Pendec sought legal protection for Pendec in countries other than the United States. For example, appellant filed an application for a Community Plant Variety Rights (CPVR) Certificate/Plant Breeder's Rights (PBR) with the Community Plant Variety Office (CPVO) in Europe for Pendec on September 3, 1997 that was assigned reference number 97/0950. Application EU 97/0950 published on December 15, 1997 in the CPVO Official Gazette. Appellant admits that Pendec was sold in Germany in July of 1998. Reply Brief, page 1.

This plant patent application was filed on September 18, 2000, more than one year after the publication date, December 15, 1997, of EU 97/0950. The examiner has rejected the claim of this plant patent application under 35 U.S.C. § 102(b), concluding that EU 97/0950 is a printed publication within the meaning of this section of the statute. The examiner understood that the bare description of a claimed invention appearing in a printed publication published more than one year prior to the effective filing date of a patent claim is not a bar to the patenting of that claim if the printed publication is non-enabled, i.e., the disclosure of the publication "must be such that a skilled artisan can take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962). Examiner's Answer, Paper No. 13, page 3. The examiner concluded that EU 97/0950 is enabled or places the skilled artisan in possession of the invention since appellant has conceded that the claimed plant, Pendec, has been on sale or commercially available in countries other than the United States beginning in July of 1998.

Appellant's position is summarized at page 4 of the Appeal Brief (Paper No. 12) as follows:

> The anticipation rejection in the present application has been characterized as based on the cited PBR application. According to the Examiner, the cited PBR application teaches every material element of the claim, despite its severe lack (or absence) of botanical information. The sale of a plant named Pendec outside the United States is used to show that the claimed subject matter was in the public domain more than one year prior to the application filing date.
>
> The rejection is flawed in its reliance on a PBR application which does not disclose every material element of the claim and its attempt to circumvent 35 U.S.C. § 102(b) to reject a claim on an invention that may have been sold outside the United States.

Appeal Brief, (Paper No. 12), page 4.

DISCUSSION[2]

In relevant part, 35 U.S.C. § 102(b) reads:[3]

> A person shall be entitled to a patent unless -- ... (b) the invention was ... described in a printed publication ... more than one year prior to the date of the application for patent in the United States, ...

However, not every "description" of something in a printed publication will necessarily bar the grant of a patent containing claims to that something. As stated in In re LeGrice, 301 F.2d at 931, 133 USPQ at 367, "[t]he underlying concept on which the

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[2] The briefing in this appeal includes the Appeal Brief (Paper No. 12), a first Examiner's Answer (Paper No. 13) and the Reply Brief (Paper No. 14). At that point in time, the examiner re-opened prosecution and issued a new final rejection (Paper No. 16). Appellant requested that the appeal be reinstated and filed a Supplemental Appeal Brief (Paper No. 17). A second Examiner's Answer was entered (Paper No. 18). Appellant declined to file a second Reply Brief. See Paper No. 19.

[3] This provision of § 102(b) is separate from the "on sale" and "public use" clause of this section of the statute. While the examiner refers to public availability of Pendec in countries other than the United States in terms of "on sale," we will use terms such as "publicly available" to describe this aspect of the evidence relied upon by the examiner to make clear that the rejection is not based on the "on sale" or "public use" provisions of § 102(b).

courts permitted such a bar is that the description of the invention in the printed publication was sufficient to give possession of the invention to the public."

Thus, the issue to be resolved is whether the "description" of the claimed geranium Pendec in EU 97/0950 is sufficient to "give possession of the invention to the public." Appellant and the examiner agree that no amount of written description of the claimed geranium Pendec would allow one to recreate the plant. This is seen in that Pendec is biological material created by a spontaneous mutation. Given the vagaries of nature and genetics, all agree that it is improbable if not impossible to recreate Pendec from the parent plant.

Here, however, the examiner does not rely upon the written words of EU 97/0950 as evidence that the printed publication placed Pendec in the possession of the public. In addition, the examiner relies upon the fact that the claimed geranium Pendec was also available to the public more than one year prior of the filing date of this plant patent application. In determining whether the description of Pendec in EU 97/0950 gave possession of the claimed plant to the public, the examiner concluded that being able to physically possess Pendec due to its public availability met the LeGrice test.

We agree with the examiner that EU 97/0950 is a statutory bar since it gave possession of Pendec to the public more than one year prior to the filing date of this plant patent application by way of (1) public announcement of the existence of Pendec by its publication and (2) the admitted public availability of the claimed plant. Simply put, it is difficult to imagine how much more the public can be put in "possession" of a claimed plant than be told of its existence by way of a printed publication and then be able to physically possess the plant by holding it in one's own hand since it is publicly available. Our reading of LeGrice and the other cases appellant relies upon does not lead us to appellant's conclusion, i.e., a description in a printed publication can only put

a claimed invention in possession of the public if the public can recreate the claimed invention from scratch. Rather, physical possession of the claimed plant is sufficient.

Appellant questions the examiner's use of multiple events to establish a statutory bar under the § 102(b), i.e., a printed publication describing a "thing" and public availability of the "thing" described in the publication. Specifically, appellant argues:

> There is some flexibility in the rule that only one reference may be used in an anticipation rejection. An additional reference may be used to prove that the primary reference discloses subject matter which is in the public's possession. MPEP § 2131.01. Pursuant to this exception, a secondary reference may be included in an anticipation rejection only when the primary reference in and of itself is an enabling disclosure. An additional reference may be used to show what the primary reference contains-- and not to supplement what the primary reference lacks. In both of In re Samour,[571 F.2d 559, 197 USPQ (CCPA 1978)] and In re Donohue,[766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985)] (each relating to patent applications on chemical inventions), an additional reference was relied upon to show that the subject matter of a primary reference was available to the public. Neither case stands for the proposition that an additional reference may be used to supplement a non-enabling disclosure of a primary reference.

Appeal Brief, (Paper No. 12), page 5.

Appellant's argument appears to be circular. Appellant first states that it is proper to rely upon an additional reference in making an anticipation rejection to establish that the subject matter described by the so-called primary reference is in the possession of the public. This is what the examiner has done in this case. However, appellant goes on to argue that a so-called secondary reference may be included in an anticipation rejection "only when the primary reference in and of itself is an enabling disclosure." This latter statement is not understood since by definition the secondary reference is needed because the primary reference is not considered to be an enabling reference. If the primary reference was an enabled reference, one would not have to resort to so-called secondary references to establish that the "thing" described by the primary reference is enabled.

In our view Samour and Donohue are relevant in considering the present issue in that they provide legal support for the proposition that additional evidence may be relied upon to establish that a so-called primary reference is in fact enabled. However, we do not read Samour or Donohue as holding that the additional evidence to be used in establishing that the primary reference is enabled is limited to printed publications as opposed to actual objects that are publicly available.

Appellant argues that an anticipatory reference must describe "every material element of the claim." See, e.g., Appeal Brief, page 6. We agree. Appellant characterizes the primary reference in Samour as teaching every material element of the claimed compound by depicting the structural formula of the claimed compound. Appeal Brief, page 6. Appellant apparently views description of a chemical compound by its structural formula in a printed publication to be different from the description of a plant by name in a printed publication. We do not. A chemical compound is a physical substance just as a plant. In order to identify a chemical compound, workers in the field use words, e.g., ethanol, or structural formulas, e.g., CH_3CH_2OH. EU 97/0950 describes a plant using words, the name Pendec, as well as a brief taxonomic description, similar to a structural formula. A printed publication which simply describes "ethanol" or "CH_3CH_2OH" does not necessarily describe how to obtain the compound which meets that description, just as a printed publication which describes the geranium Pendec, either by name or the most detailed taxonomic description, may not describe how to obtain that plant. Rather, workers in the respective fields must rely upon publicly available knowledge and their ordinary skill in order to obtain the chemical or the plant. Chemical compounds can be synthesized. That endeavor may be simple or complex. In Donohue and Samour, the USPTO provided sufficient evidence to conclude that a

worker in the relevant field would be able to obtain the compounds in dispute by way of synthesis using publicly available knowledge and routine skill.

While it is agreed that it is improbable if not impossible to recreate Pendec from the parent plant, the public is put in possession of Pendec just as assuredly as the chemical compounds in Donohue and Samour, if not more so by its public availability. This is seen in that the evidence relied upon by the USPTO in Donohue and Samour only provided instructions to one of ordinary skill in the art as to how to obtain the claimed compounds. One need not be concerned about "making" Pendec since appellant admits that it was publicly available in the relevant time frame. Again, physical possession of a claimed "thing" resolves any question that one can actually recreate the "thing" by way of instructions and knowledge contained in printed publications such as those relied upon in Donohue and Samour.

We note that the evidence relied upon by the examiners in Samour and Donohue established a constructive "possession" of the claimed compounds, not an actual "possession." If enablement of a reference can be established by evidence establishing that one could constructively be placed in possession of the claimed subject matter, it stands to reason that actual possession should also provide enablement. One should not have to reinvent the wheel if the wheel is publicly available.

Appellant argues that a plant cannot be reproduced from a description of the plant in a printed publication, relying upon the declaration filed under 37 CFR § 1.132 by Dr. Richard Craig. Appeal Brief, pages 9-11. That is not in issue as we agree that it is improbable if not impossible to recreate a plant from a written description of the plant.

Appellant also argues:

> The LeGrice opinion does not directly address enablement of the printed publications on the claimed rose plant based on any other source, such as public availability of the plant.
>
> However, implicit in LeGrice is that a publication describing a plant and a source to obtain that plant is not prior art to a plant patent application on that plant. The publications at issue in LeGrice included a national British publication on roses which disclosed the source of the rose plant at issue including the breeder's name and location and a catalog showing the rose plant. Although not specifically stated in LeGrice, the catalog indicated commercial availability of the rose plant. One skilled in the art, a plant breeder, could have determined the name and source of the rose plant and tracked down the rose plant. Despite availability of the rose plant (evidenced by the catalog), the court held the two publications to be incapable of placing the rose plant in the public domain. As should be true in this present application, the public use or sale of the rose plant outside the United States (such as via the catalog) were not of concern to the court in its analysis of statutory bars under 35 U.S.C. § 102(b).

Appeal Brief, page 11, (footnote omitted). This argument misapprehends the nature of appellate review. The record forwarded to an appellate tribunal contains numerous facts. However, not all facts contained in the record are relevant in deciding the issue framed and presented by the parties below. The question put squarely to the Board and the CCPA in LeGrice was whether a printed publication under § 102(b) must be enabling in the first instance, not how a printed publication can be considered enabled. The Board decided that a § 102(b) printed publication need not be enabled in the first instance. The CCPA reversed that decision, holding that a § 102(b) printed publication must be enabling. The question of how or in what manner a § 102(b) printed publication can be enabling was not presented to or decided by either tribunal. The examiner and Board could have presented a two tiered issue for review. First, whether a § 102(b) publication needs to be enabling in the first instance and second, if the first issue is answered in the affirmative, does the public availability of the plants provide the needed enablement. However neither the examiner nor the Board did so. Only the first issue was decided by the Board and CCPA.

We also note the examiner and appellant have discussed the relevance that a previous board decision, Ex parte Thomson, 24 USPQ2d 1618 (Bd. Pat. App. & Int. 1992) has on the facts of this case. Thomson was decided by a three member merits panel of the Board. At best the decision in Thomson constitutes the law of that case and would govern any further proceedings within the agency in regard to that patent application or its progeny. It is not controlling in this case. What is controlling in this case are the patent statutes and relevant precedent from the Federal Circuit and the CCPA. Thus we will not engage in a discussion of the facts or holdings of Thomson.

Appellant argues on page 15-17 of the Appeal Brief that:

> An asexually reproduced plant is expected to have the same botanical characteristics as its parent plant. However, a mutation (spontaneous or otherwise) can cause an asexually reproduced plant to exhibit characteristics different from its parent plant. The characteristics of the plant described in EU 97/0980 are not identical to the characteristics specified in the claimed plant. EU 97/0950 simply does not contain sufficient information to indicate what particular variety is described therein, despite having the name 'Pendec'. As noted above, many pale pink geraniums could fit the description in EU 97/0950. Hence, the present application is more than just a better description of a plant described in EU 97/0950-- it is the definitive description of the variety named 'Pendec' claimed in the present application. The attempt to cast the botanical characteristics of the present invention as inherent properties of a vaguely described plant named 'Pendec' is an improper interpretation of and reliance on Donohue relating to the inherent properties of chemical compounds.

Appeal Brief, paragraph bridging pages 16-17.

We agree with appellant that the present application provides a better written description of Pendec than does EU 97/0950. However, that is beside the point in that neither written description enables one to recreate Pendec. What is significant is that appellant has not established the claimed Pendec differs from the Pendec described in EU 97/0950 and the Pendec which was publicly available in Germany more than one year prior to the filing date of this plant patent application.

In considering appellant's position in this appeal, we find it significant that the CCPA cast the test for an enabled printed publication under § 102(b) in terms of "possession of the invention" instead of using the "make and use" language found in the enablement requirement of 35 U.S.C. § 112, first paragraph. The ordinary and customary meaning of the word "possession" is "a possessing or being possessed; ownership, occupancy, hold, etc."[4] One can possess something such as a plant without knowing how to make it or for that matter how it was made. Again, how can one be any more in "possession" of a claimed invention than to be able to hold the claimed invention in one's hands as here? The undisputed facts in this case establish that the public and consequently those of skill in this art were put on notice of the existence of Pendec by way of the printed publication relied upon by the examiner and the public and those skilled in the art were put in possession of the claimed plant by the public availability of Pendec.

Our agreement with the examiner's position that the "possession" test of LeGrice is satisfied by physical possession of the claimed invention as opposed to having constructive possession by knowing how to "make" the claimed invention is consistent with the manner in which enablement questions have been treated in utility applications claiming inventions involving biological material. In In re Argoudelis, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970), the claims under review were directed to new antibiotic compounds produced by a microorganism. It was conceded that the claimed antibiotic compounds could only be made if one had access to the microorganism starting material. Argoudelis at 1392, 168 USPQ at 100-101. However, as observed by the CCPA, one "cannot sufficiently disclose by written word how to obtain the

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[4] Webster's New World Dictionary of the American Language, Second College Edition, p. 1112 (The World Publishing Company 1972)

microorganism starting material from nature." Argoudelis at 1392, 168 USPQ at 101-102. As explained:

> [A] unique aspect of using microorganisms as starting materials is that a sufficient description of how to obtain the microorganism from nature cannot be given. Such a description could only detail an experimental screening program similar to the screening programs followed in discovering the microorganism in the first instance. If the microorganism involved were of very common occurrence, it might be found in a relatively short time, but if it were not of common occurrence, it might not be found for a very long time, if found at all. The microorganism involved here, of course, was not known and available to the workers in the art since it was newly discovered by appellants.

Argoudelis at 1392, 168 USPQ at 102.

Given those circumstances where an applicant for a utility patent could not describe by way of words how to make a needed biological material, the CCPA determined that the applicant could deposit the needed biological material in a public depository under conditions assuring access by the public to the biological material upon issuance of a patent. Thus, such utility patents are considered enabled, not by the fact that the public can make or recreate the needed biological material, but by the fact that the public is given possession of the needed biological material upon issuance of the patent. Since the time of Argoudelis, the procedures for the deposit of biological material in order to comply with the enablement requirement under 35 U.S.C. § 112, first paragraph, have been the subject of rule making by the USPTO and are now codified in 37 CFR §§ 1.801 - 1.809. 37 CFR § 1.802(b) reads:

> Biological material need not be deposited unless access to such material is necessary for the satisfaction of the statutory requirements for patentability under 35 U.S.C. 112. If a deposit is necessary, it shall be acceptable if made in accordance with these regulations. Biological material need not be deposited, inter alia, if it is known and readily available to the public or can be made or isolated without undue experimentation. Once deposited in a depository complying with these regulations, a biological material will be considered to be readily available even though some requirement of law or regulation of the United States or

> of the country in which the depository institution is located permits access to the material only under conditions imposed for safety, public health or similar reasons.

As seen, an applicant need not deposit needed biological material if that material is publically available or can be made or isolated. The deposit rules equate existing public availability of needed biological material, the ability of the public to make, recreate or re-isolate the material and deposit of the material with access to public upon issuance of a patent. Any of these three circumstances will satisfy the enablement requirement. It makes little sense to say that a utility patent is enabled by way of the public being able to physically possess needed biological material where written words do not suffice to instruct one of ordinary skill in the art how to make or recreate the material, yet say that a printed publication describing the existence of a plant is nonenabled even though the public can in similar manner "possess" the plant due to its public availability.

The public availability of Pendec in countries other than the United States does not negate its effect in enabling the printed publication relied upon by the examiner. A similar issue was considered in In re Metcalfe, 410 F.2d 1378, 161 USPQ 789 (CCPA 1969) in the context of whether claims pending in a utility application were enabled. One of the issues resolved in Metcalfe was whether pamphlets from Australian companies could be relied upon as evidence that the pending claims were enabled when it was not clear the pamphlets were available in the United States. The court stated "we are unaware of any authority holding that published material of the type under consideration must be from the United States. Section 112 simply requires that a disclosure of an invention enable any man skilled in the relevant art to make and use it. No mention of convenience is made; thus, even if the origin of the material is in

Australia, this is merely a matter of degree of convenience and not a matter of lack of availability." Metcalfe, at 1381, 161 USPQ at 791.

We think this principle applies equally to the present situation in considering whether the printed publication relied upon by the examiner is enabled. The public availability of Pendec in countries other than the United States is a matter of convenience, not access. The printed publication clause of § 102(b) is not limited to publications "in this country" as are the "on sale" and "public use" clauses. Since the printed publication clause of § 102(b) is not limited by location, we see no reason to geographically limit the evidence available to be used in determining whether a printed publication is enabled. In our view, description of a claimed plant in a printed publication more than one year prior to the filing date for a plant application patent in this country, coupled with the public availability of the plant in countries other than the United States creates a statutory bar to obtaining a plant patent on the plant.[5]

Appellant argues that asserting a PBR publication is enabling prior art alone or in combination with the sale or use outside the United States is inconsistent with the examination practice of requiring detailed botanical information in plant patent applications. Appeal Brief, page 18. It is not clear what point appellant is making here. Whether a specification of a plant patent application contains sufficient information to describe the plant in issue is separate and distinct from whether a prior art reference is

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[5] While not relied upon by appellant, we have reviewed In re Foster, 343 F.2d 980, 145 USPQ 166 (CCPA 1966), cert. denied, 383 U.S. 966 (1966) since the case also discusses the requirements of 35 U.S.C. § 102(b), albeit in a different context. In Foster, the court observed:

> "[S]ince the purpose of [§ 102(b)] has always been to require filing of the application within the prescribed period after the public came into possession of the invention, we cannot see that it makes any difference how [it] came into such possession, whether by a public use, a sale, a single patent or publication, or by combination of one or more of the foregoing."

Foster, at 988, 145 USPQ at 173. In making this observation the court did not limit "public use" and "a sale" to those which occur in this country. While it is not clear from the opinion whether the court meant for those terms to be unlimited by geography, it is clear that a combination of events may be used to establish a § 102(b) bar.

enabling. The amount of description a specification need contain in a plant patent application in order to comply with the requirements of 35 U.S.C. § 162 is not before us for review in this appeal.

Appellant argues that the rejection in this case places the "foreign plant patent breeder at a distinct economic disadvantage." Appeal Brief, pages 19-20. In considering this argument, we note our decision does not foreclose or prevent access to the United States patent system by a plant breeder, regardless of whether the breeder conducts his business in this country or in a country other than the United States. What our decision means is that plant breeders must file their plant patent applications in the United States in a more timely manner than apparently has been the practice. We find no legal impediment to plant breeders, including the present appellant, filing their plant patent applications in the United States within a year of describing their plant in a printed publication and providing access to the public to the plant overseas.

Appellant appears to be of the mind that plant breeders should be free to pursue legal protection of a plant in the countries other than the United States and in so doing provide public notice of the existence of a plant concurrent with making the plant available to the public in countries other than the United States by way of commercial sales or other avenues, yet be able to delay seeking patent protection in this country until they decide whether the plant is commercially important in this country. We have no doubt that many industries and inventors would find that set of circumstances desirable. However this is not what the patent statues provide for in this country. The CCPA stated in LeGrice that the plant patent statutes, 35 U.S.C. §§ 161-164, provide a single exception to the other statutory requirements for granting of a patent. LeGrice at 933, 133 USPQ at 369 ("35 U.S.C. § 161 engrafts the Plant Patent Act onto the basic

patent law, which requires us to apply thereto all the rules, regulations and provisions of the basic patent law except that, by the express provision of 35 U.S.C. 162, a plant patent cannot be declared invalid if its description 'is as complete as is reasonably possible'"). We do not find it appropriate to create another exception for appellant.

Nor do we find the argued cost burden to be unique to plant breeders. There are no doubt many industries and inventors faced with difficult decisions as to which inventions to seek patent protection. Such decisions are based in large part on, if not governed by, economic circumstances. It must be remembered that it was appellant's own actions which resulted in the printed publication that forms the basis for the present rejection and appellant's own actions which placed the claimed plant on sale overseas or otherwise made the plant publicly available in the relevant time frame. If appellant wanted the luxury of delaying his decision as to which plants should be protected by plant patents in the United States, appellant should have developed the present plant to the point of deciding whether it is commercially viable in this country without generating statutory bars under 35 U.S.C. § 102(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Sherman D. Winters
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

Russell D. Orkin
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

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APPENDIX B

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANDREA MICHALIK

Appeal No. 2004-0386
Application No. 09/733,016

VACATUR AND REMAND

Before WILLIAM F. SMITH, ADAMS, and GRIMES, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

This appeal involves plant patent Application No. 09/733,016. The question raised in this appeal involves whether evidence of foreign sales of the claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing the plant, thereby creating a bar under 35 U.S.C. § 102(b). The Court of Appeals for the Federal Circuit considered that issue in In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004), and held in the affirmative. Id. at 1128, 72 USPQ2d at 1041. In so holding, the court stated that "[t]he foreign sale must not be an

obscure, solitary occurrence that would go unnoticed by those skilled in the art." Id. at 1131, 72 USPQ2d at 1043. The court also stated that the record did not establish that "even if the interested public would readily know of the foreign sales, those sales enabled one of ordinary skill in the art to reproduce the claimed plants without undue experimentation." Id. Thus, the court vacated the Board's decision and remanded the case for "further factual findings relating to the accessibility of the foreign sales of the claimed plants and the reproducibility of the claimed plants from the plants that were sold." Id.

In this case, the examiner is relying upon applicant's admission that the claimed plant "was sold outside the United States on or about July 1, 1998" as evidence that QZ PBR 980521, PL PBR PBO 0050, CZ PBR OPPH 06594, and ZA PBR 02603 are enabled. Examiner's Answer, pages 4-7. However, there is no evidence whether the sales were of the type that would be noticed by those of skill in the art. Nor has the other issue raised by the Federal Circuit in Elsner, whether the sales would enable one skilled in the art to reproduce the claimed plant without undue experimentation, been addressed.

Accordingly, we vacate the examiner's rejection and remand the case to the examiner to determine whether the sales of the claimed plant (1) were "an obscure,

solitary occurrence that would go unnoticed by those skilled in the art" and (2) would enable one to reproduce the plant without undue experimentation.

VACATED; REMANDED

William F. Smith Administrative Patent Judge	)))
	) BOARD OF PATENT)
Donald E. Adams Administrative Patent Judge	)) APPEALS AND)
	) INTERFERENCES)
Eric Grimes Administrative Patent Judge	))

Webb, Ziesenheim, Logsdon,
Orkin & Hanson, PC
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219

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APPENDIX B

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WILHELMUS IBES

Appeal No. 2004-0447
Application No. 09/733,020

VACATUR AND REMAND

Before WILLIAM F. SMITH, ADAMS, and GRIMES, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

This appeal involves plant patent Application No. 09/733,020. The question raised in this appeal involves whether evidence of foreign sales of the claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing the plant, thereby creating a bar under 35 U.S.C. § 102(b). The Court of Appeals for the Federal Circuit considered that issue in In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004), and held in the affirmative. Id. at 1128, 72 USPQ2d at 1041. In so holding, the court stated that "[t]he foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art." Id. at 1131, 72 USPQ2d at 1043. The court also stated that the record did not establish that "even if the interested public would readily know of the foreign sales, those sales enabled one of ordinary skill in the art to reproduce the claimed plants without undue

experimentation." Id. Thus, the court vacated the Board's decision and remanded the case for "further factual findings relating to the accessibility of the foreign sales of the claimed plants and the reproducibility of the claimed plants from the plants that were sold."Id.

In this case, the examiner is relying upon applicant's admission that the claimed plant "was sold outside the United States on or about March 1, 1999" as evidence that PBR 981669 (European Union) is enabled. Examiner's Answer, page 4. However, there is no evidence whether the sales were of the type that would be noticed by those of skill in the art. Nor has the other issue raised by the Federal Circuit in Elsner, whether the sales would enable one skilled in the art to reproduce the claimed plant without undue experimentation, been addressed.

Accordingly, we vacate the examiner's rejection and remand the case to the examiner to determine whether the sales of the claimed plant (1) were "an obscure, solitary occurrence that would go unnoticed by those skilled in the art" and (2) would enable one to reproduce the plant without undue experimentation.

VACATED; REMANDED

William F. Smith Administrative Patent Judge	)
	) BOARD OF PATENT
Donald E. Adams Administrative Patent Judge	) APPEALS AND
	) INTERFERENCES
Eric Grimes Administrative Patent Judge	)

Russell D. Orkin
Webb, Ziesenheim, Logsdon,
Orkin & Hanson, PC
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

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APPENDIX B

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WILHELM ELSNER

Appeal No. 2004-0167
Application No. 09/753,976

VACATUR AND REMAND

Before WILLIAM F. SMITH, ADAMS, and GRIMES, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

This appeal involves plant patent Application No. 09/753,976. The question raised in this appeal involves whether evidence of foreign sales of the claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing the plant, thereby creating a bar under 35 U.S.C. § 102(b). The Court of Appeals for the Federal Circuit considered that issue in In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004), and held in the affirmative. Id. at 1128, 72 USPQ2d at 1041. In so holding, the court stated that "[t]he foreign sale must not be an

obscure, solitary occurrence that would go unnoticed by those skilled in the art." Id. at 1131, 72 USPQ2d at 1043. The court also stated that the record did not establish that "even if the interested public would readily know of the foreign sales, those sales enabled one of ordinary skill in the art to reproduce the claimed plants without undue experimentation." Id. Thus, the court vacated the Board's decision and remanded the case for "further factual findings relating to the accessibility of the foreign sales of the claimed plants and the reproducibility of the claimed plants from the plants that were sold." Id.

In this case, the examiner is relying upon applicant's admission that the claimed plant "was first offered for sale in Europe in October 1998" as evidence that European Community Plant Breeder's Rights Application No. 98/1018 is enabled. Examiner's Answer, page 3. However, there is no evidence whether the sales were of the type that would be noticed by those of skill in the art. Nor has the other issue raised by the Federal Circuit in Elsner, whether the sales would enable one skilled in the art to reproduce the claimed plant without undue experimentation, been addressed.

Accordingly, we vacate the examiner's rejection and remand the case to the examiner to determine whether the sales of the claimed plant (1) were "an obscure,

solitary occurrence that would go unnoticed by those skilled in the art" and (2) would enable one to reproduce the plant without undue experimentation.

VACATED; REMANDED

William F. Smith Administrative Patent Judge	)))
	) BOARD OF PATENT)
Donald E. Adams Administrative Patent Judge	)) APPEALS AND)
	) INTERFERENCES)
Eric Grimes Administrative Patent Judge	))

Webb, Ziesenheim, Logsdon,
Orkin & Hanson, PC
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219

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APPENDIX B

United States Court of Appeals for the Federal Circuit

03-1569

IN RE WILHELM ELSNER

JUDGMENT

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

in Case NO(S). 09/664,247

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

VACATED AND REMANDED

ENTERED BY ORDER OF THE COURT

DATED AUG 16 2004

Jan Horbaly, Clerk

ISSUED AS A MANDATE: NOV 30 2004

COPY

United States Court of Appeals for the Federal Circuit

03-1569
(Serial No. 09/664,247)

IN RE WILHELM ELSNER

Julie W. Meder, Webb Ziesenheim Logsdon Orkin & Hanson, P.C., of Pittsburgh, Pennsylvania, argued for appellant. Russell D. Orkin for appellant.

John M. Whealan, Solicitor, United States Patent and Trademark Office, of Arlington, Virginia, argued for appellee. With him on the brief were Stephen Walsh and Linda Moncys Isacson, Associate Solicitors.

Appealed from: United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

United States Court of Appeals for the Federal Circuit

03-1569
(Serial No. 09/664,247)

IN RE WILHELM ELSNER

03-1585
(Serial No. 09/267,559)

IN RE KEITH ZARY

DECIDED: August 16, 2004

Before LOURIE, CLEVENGER, and BRYSON, Circuit Judges.

LOURIE, Circuit Judge.

Wilhelm Elsner appeals from the decision of the United States Patent and Trademark Office ("PTO") Board of Patent Appeals and Interferences affirming the rejection of claim 1 of United States plant patent application 09/664,247 as anticipated under 35 U.S.C. § 102(b). Ex Parte Elsner, No. 2003-0841 (Bd. Pat. Apps. & Interfs. Mar. 26, 2003). Similarly, Keith Zary appeals from the decision of the Board affirming the § 102(b) rejection of the sole claim of United States plant patent application 09/267,559. Ex Parte Zary, No. 2003-0703 (Bd. Pat. Apps. & Interfs. Mar. 26, 2003).[1]

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[1] Both appeals were heard together by the Board and decided concurrently, but the Board issued separate opinions. Here, because the cases raise the same legal issue, we resolve them in this single opinion. Accordingly, Elsner and Zary are referred to herein as "Appellants."

The Board determined that Appellants' published Plant Breeder's Rights applications anticipated their claims in view of the foreign sales of the claimed plants. We agree that the publication of the applications coupled with foreign sales of the plants may constitute a §102(b) bar to patentability. However, because the record is silent on the extent to which the foreign sales were known to the public, and because the Board did not adequately address the degree to which availability of the plants through foreign sales enabled the preparation of the claimed plants, we vacate the Board's decisions in both cases and remand for further proceedings.

BACKGROUND

I. The Elsner Application

Mr. Wilhelm Elsner is a plant breeder who resides in Germany and whose botanical products include various varieties of geraniums. In September 1997, he filed an application for a Community Plant Variety Rights ("CPVR") Certificate, or Plant Breeder's Rights ("PBR"), at the Community Plant Variety Office ("CPVO") in Europe for a type of geranium named "Pendec." The variety originated as a mutation of a parent geranium plant named "Pendresd." Elsner's application, designated EU 97/0950, was listed in the CPVO Official Gazette that was published in December 1997. That listing disclosed the names and addresses of the breeder and its representative, a statement of botanical classification, and a provisional denomination for the plant. In July 1998, a sale of the Pendec geranium occurred in Germany. Elsner withdrew the application in May 1999, and it did not therefore mature into a CPVR certificate.

In September 2000, Elsner filed a plant patent application at the PTO claiming the Pendec geranium. The patent examiner rejected the only claim in the application

as anticipated under 35 U.S.C. § 102(b), on the ground that the EU 97/0950 listing had been published more than one year before the effective filing date of Elsner's U.S. application. She concluded that the listing disclosed the invention and that the sales placed the skilled artisan in possession of the invention. Elsner appealed to the Board, which affirmed the rejection, and Elsner appeals to this court.

II. The Zary Application

In March 1995, Dr. Keith Zary filed a PBR application in South Africa that claimed a variety of rose plant named "JACopper," a cross between two other rose varieties. The application was published in April of that same year, and it listed information concerning how the breeder, as well as the breeder's South African agent, could be contacted. The JACopper plant was thereafter sold in South Africa and Zambia as early as October 1996.

In March 1999, Zary filed a plant patent application at the PTO claiming the JACopper rose plant. The examiner issued a rejection under § 102(b), stating that the published PBR application was a printed publication that enabled the invention and placed the skilled artisan in possession of the invention because of the public availability of JACopper in South Africa and Zambia. Upon Zary's appeal, the Board affirmed the examiner's rejection, holding that the description of the JACopper plant in a printed publication, combined with the foreign public availability of that plant more than one year before Zary's filing date, constituted a statutory bar. Zary now appeals to this court.

We have jurisdiction over both appeals pursuant to 28 U.S.C. § 1295(a)(4).

DISCUSSION

We review legal determinations of the Board, including whether a printed publication is enabled, without deference. In re Kollar, 286 F.3d 1326, 1329 (Fed. Cir. 2002). "Whether a prior art reference is enabling is a question of law based upon underlying factual findings." Minn. Mining & Mfg. Co. v. Chemque, Inc., 303 F.3d 1294, 1301 (Fed. Cir. 2002). We review the factual findings underlying those determinations for substantial evidence. In re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000).

On appeal, Elsner and Zary argue that the Court of Customs and Patent Appeals held in In re LeGrice, 301 F.2d 929 (CCPA 1962), that foreign activity cannot cause a non-enabled publication to constitute a statutory bar under § 102(b).[2] The appellants further assert that, because foreign sales are not prior art under the patent statute, they may not be considered within the knowledge of one of skill in the art and cannot be used to enable an otherwise non-enabled publication. They claim that the published PBR applications are not enabled because it is impossible to recreate the claimed plants from the textual descriptions alone, and they assert that the published applications are therefore not effective as § 102(b) references.

The PTO asserts that LeGrice did not squarely address whether a publication may be enabled through a foreign sale. The PTO further argues that the LeGrice court adopted a "possession" test as a measure of enablement of a publication and that the Board properly applied that test to Elsner's and Zary's applications. The correct inquiry,

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[2] Section 102 of 35 U.S.C. provides in relevant part that "[a] person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States."

the PTO argues, is whether the printed publication put the public in possession of the claimed invention before the critical date. That is the fundamental policy behind § 102(b), the PTO urges, and it supports the rejection of the claims over the published PBR applications in view of the foreign sales.

The particular question thus before us is whether evidence of the foreign sale of a claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing that plant, thereby creating a § 102(b) bar. On that issue of first impression, we hold in the affirmative.

Prior art under § 102(b) must sufficiently describe a claimed invention to have placed the public in possession of that invention. In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985); In re Samour, 571 F.2d 559, 562 (CCPA 1978). The proper test of a publication as a § 102(b) bar is "whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought." LeGrice, 301 F.2d at 939. In particular, one must be able to make the claimed invention without undue experimentation.

It is undisputed that the PBR applications were published more than one year prior to the effective filing dates of Appellants' respective applications and that the applications fully disclose the claimed plants. It is also clear that the foreign sales of the Pendec geranium and the JACopper rose are not themselves § 102(b) prior art against the applications; that is, those foreign sales themselves do not constitute an on-sale bar. Ordinarily, foreign sales of an invention in combination with a publication will

not constitute a bar because such a result would circumvent the established rules that neither non-enabling publications nor foreign sales can bar one's right to a patent. What sets this case apart is that it deals with plant patents, which may be granted to "[w]hoever invents or discovers and asexually reproduces any distinct and new variety of plant . . . ." 35 U.S.C. § 161 (2000). The grant accompanying a plant patent includes "the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts . . . ." Id. § 163. The PTO asserts that when a publication is combined with a foreign sale which results in possession of the plant by one of skill in the art, it is that possession alone which is capable of enabling the publication. That is not correct. Only when possession derived in this manner enables a person of skill in the art to practice asexual reproduction of the plant in a manner consistent with the statute can a non-enabling publication and foreign sale act as a § 102(b) bar.

Because we perceive a difference between plants and statutorily distinct inventions, we disagree with Appellants' contention that this holding will operate to create a printed publication bar whenever a non-enabling publication and a foreign sale are involved. As our predecessor court noted in LeGrice, "there are inherent differences between plants and manufactured articles." 301 F.2d at 935. In the case of plant patents, the touchstone of the statutory subject matter is asexual reproduction of a unique biological organism. When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts

and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar. In any event, the inventor is in control of the activities relating to his invention, and avoidance of a bar is accomplished by making a timely filing at the PTO.

Appellants' PBR applications disclosed the claimed plant varieties, but concededly do not, by themselves, enable the skilled artisan to practice the claimed inventions or reproduce the plants. However, because the public may have had access to the claimed inventions through the foreign sales of the plants, from which the claimed plants may be reproduced, it may fairly be said that the PBR applications are adequately enabled. Because the published applications, combined with the foreign sales of the plants, placed the claimed inventions in the possession of the public, we therefore hold that they are proper § 102(b) anticipatory references that may bar patentability.

Our predecessor court's decision in Samour supports the use of secondary references to show that a primary § 102(b) reference was in fact enabled. In that case, the applicant claimed a small genus of chemical compounds useful as anticonvulsant agents. The Board affirmed a § 102(b) rejection that a printed publication by Doran anticipated the claimed invention. The Doran reference disclosed the structure of a compound within the claimed genus, but failed to describe a method of preparing the compound. Although the applicant argued that the reference was non-enabled, the Board relied on additional references to show that the skilled artisan would have known how to prepare the compound disclosed by Doran. The court affirmed the Board's decision, reasoning that additional references cited in a § 102(b) rejection are relied on

"to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in [the] possession of the public." 571 F.2d at 563; see also Donohue, 766 F.2d at 534 (affirming a § 102(b) rejection wherein additional references were used to show that a primary reference which disclosed every element of the claimed invention was enabled). Likewise, the listings of the PBR applications filed by Elsner and Zary were considered the primary references, and they completely disclosed the claimed plant varieties. The Board justifiably relied on the foreign sales to show that the public was in possession of the claimed plants and thus that the PBR applications were enabled anticipatory references.

Appellants argue that foreign sales are not prior art and may not be considered within the knowledge of a skilled artisan. However, the precise focus of the analysis is not whether the foreign sales are themselves § 102(b) prior art, but whether the publication has placed the claimed invention in the possession of the public before the critical date. Thus, foreign sales of the claimed plants may be within the knowledge of the skilled artisan and may be considered to provide the public with access to Appellants' inventions.

We disagree with Appellants that our holding conflicts with LeGrice. In that case, the Board had affirmed rejections of plant patent applications based on catalogs depicting the claimed plants. Specifically, the Board stated that a reference did not have to be enabled to anticipate a claim. In its decision reversing the Board, the Court of Customs and Patent Appeals discussed at length its view that § 102(b) applies to plant patents in the same way that it applies to utility patents, but acknowledged the distinction between plants and other patentable subject matter. 301 F.2d at 935. The

court considered that the textual description of manufactured articles, processes, and even chemical compositions can often enable others to practice the invention; however, the mere description of a plant in a catalog may do little to enable one of skill in the art to recreate that claimed plant. Id.

The court concluded that Congress had not indicated that § 102(b) should be applied differently to plant patents than to other inventions, and the court reiterated that "the clause 'described in a printed publication' has been interpreted with respect to whether the publication has in fact conveyed such knowledge of an invention to the public as to put the public in possession of the invention." Id. at 936. Thus, the court held that

> it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.

Id. Accordingly, the court reversed the Board's decision and held that a disclosure must be enabled to be a statutory bar to a plant patent.

We agree with the PTO that LeGrice decided only the narrow issue whether a printed publication of a plant patent that is not enabled is a statutory bar. That decision did not address the manner in which a publication may be enabled, and it did not decide whether other evidence such as the availability of an invention through foreign sales may be considered in determining whether a printed publication enables a skilled artisan to reproduce a claimed plant. In fact, there was no mention of sales in the LeGrice opinion. We therefore conclude that LeGrice left that issue open, and our decision today is not inconsistent with LeGrice.

Additionally, our holding is consistent with the treatment of § 112 enablement in utility patent applications. Specifically, in In re Argoudelis, 434 F.2d 1390 (CCPA 1970), the Court of Customs and Patent Appeals held that a utility patent claiming antibiotic compounds produced by a microorganism was enabled by depositing the microorganism in a public depository. Importantly, the court noted that "because of the particular area of technology involved," an applicant may not be able to "sufficiently disclose by written word how to obtain the microorganism starting material from nature." Id. at 1392. The court acknowledged that "[a]ny person skilled in the art with access to the pending application . . . can reproduce the invention from the written disclosure as it was originally filed." Id. at 1393. The Argoudelis court thus recognized that the deposit procedures permitted public access to the microorganism, and that such access adequately satisfied the § 112 enablement requirement. Id. at 1394; see also In re Paulsen, 30 F.3d 1475, 1481 n.9 (Fed. Cir. 1994) (describing the connection between § 112 enablement and the enablement requirement of § 102(b) prior art). It is important to note that it was not mere possession of the microorganism that was important in Argoudelis, but such possession that enabled one of ordinary skill to make the claimed invention. Similarly here. Just as the public had access to the microorganism in Argoudelis, so too might the public have had access through the foreign sales to the plant varieties that Elsner and Zary claim.

Nevertheless, although we agree with the PTO that foreign sales may enable an otherwise non-enabling publication, we find that factual issues remain with respect to the accessibility of the foreign sales of the claimed plants and the reproducibility of the plants. The Board did not specifically address how readily one skilled in the art could

have learned of the foreign sales from the printed PBR applications. In the present appeals, the examiners discovered the PBR applications through a search of the relevant PBR database. They subsequently asked Appellants to provide copies of the applications, as well as any additional information regarding the claimed plant varieties. Both appellants responded that the claimed plants had been on sale in foreign countries. It is unclear, however, whether a skilled artisan would have known of the foreign sales. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available. See In re Bayer, 568 F.2d 1357, 1361 (CCPA 1978) ("[A] printed document may qualify as a 'publication' under 35 U.S.C. § 102(b) . . . so long as accessibility is sufficient to raise a presumption that the public concerned with the art would know of the invention." (quotation omitted)). We have stated before with respect to prior art references that "[a]ccessibility goes to the issue of whether interested members of the relevant public could obtain the information if they wanted to." Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1569 (Fed. Cir. 1988).

Moreover, the Board did not find that, even if the interested public would readily know of the foreign sales, those sales enabled one of ordinary skill in the art to reproduce the claimed plants without undue experimentation. Such a determination is critical to the question whether the foreign sales would enable the printed publications.

We therefore remand both cases for further factual findings relating to the accessibility of the foreign sales of the claimed plants and the reproducibility of the claimed plants from the plants that were sold.

CONCLUSION

Because the record must be developed further with respect to the foreign sales of Elsner's Pendec geranium and Zary's JACopper rose variety, we vacate the Board's decisions and remand the cases for additional proceedings.

VACATED AND REMANDED.

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